

S/N 09/822,623
Amendment & Response
Attorney Docket 8195.28US01

REMARKS

This Amendment is submitted in response to the Office Action mailed November 29, 2002. Claims 1, 10, 13 and 23 are amended herein. Claim 25 is cancelled. New claims 33-37 are added, which are supported in the specification by claims 10 and 11 and at page 7, lines 17-23. No new matter is added by these amendments. Claims 1, 3-13, 15-24 and 26-37 are pending.

Claim Amendments

Claims 1, 13 and 23 are amended to better clarify that the flexible substrate is a flexible label substrate. Claim 10 is amended to correct its dependency. Claim 23 is amended to clarify the relationship between the first adhesive field and the second adhesive field of the adhesive construction of the present invention. Applicants respectfully submit that these amendments do not narrow the amended claims but merely clarify their intended meaning.

Claim Rejections under 35 U.S.C. 112

Claims 1, 3-13, 15 and 21-32 were rejected under 35 U.S.C. 112, first paragraph as based on a disclosure that is not enabling. The Examiner stated that the improvements that prevent the label edge from being inadvertently lifted or separated from the substrate were argued, but not included in the claim. The Examiner further stated that the limitations relating to the reduced amount of adhesive in the perimeter field which facilitate the label being retained in place and not being inadvertently lifted or separated from the substrate, as described in the Specification at page 10, lines 25-29, are not incorporated in the independent claims. Applicants respectfully traverse this rejection. Independent claims 1, 11, 13, and 23 all specify a first adhesive field adjacent an outer perimeter edge of the adhesive construction, where the first adhesive field includes a discontinuous pattern of adhesive with adhesive covering no more than 80% of its area. A second adhesive field surrounded by the first adhesive field includes adhesive covering at least 90% of its area. Therefore, the independent claims all clearly specify a reduced adhesive perimeter field.

S/N 09/822,623
Amendment & Response
Attorney Docket 8195.28US01

The Office Action notes that the claims do not mention the allegedly solved problem, and suggests that all the independent claims be amended to include a recitation of the problem in the preambles. Applicant respectfully submits that the structure that solves this problem is already included in the independent claims, and it is not necessary to describe the problem in the preamble.

Claims 23-32 were rejected under 35 U.S.C. 112, second paragraph as being indefinite. Applicant respectfully traverses the rejection, but submits that the claim amendments to claim 23, which clarify the meaning of claim 23, should address any confusion.

Claim Rejections under 35 U.S.C. 103

Claims 1, 3-13, 15 and 21-32 were rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent 5,351,426 (Voy) in view of U.S. Patent 5,700,536 (Steidinger). Applicant respectfully traverses the rejection on two grounds. First, the combination of Voy and Steidinger does not teach the claimed invention because specific elements of the claims are not present in either Voy, Steidinger or their combination. Second, the content of Voy teaches away from a combination with Steidinger, so that the combination of the two references is not proper. For at least these reasons, Applicant respectfully submits that the pending claims are in condition for allowance.

The Combination does not Teach the Claims

Claim 1 relates to an adhesive construction including a flexible label substrate with a first adhesive field having a discontinuous pattern of adhesive covering no more than 80% of its area. The first adhesive field includes an outer perimeter adhesive field that is adjacent to and within an outer perimeter edge of the flexible label substrate. The Examiner argues that the combination of Voy and Steidinger teaches such an arrangement, asserting that the area having the adhesive dots of Figure 6 in Steidinger is a similar first adhesive field. Applicant respectfully traverses this assertion.

Steidinger teaches that the dots 432 of adhesive are similar to the lines of adhesive 127, 128 forming a secondary adhesive pattern in Figure 3. As shown in Figures 3-6 of

S/N 09/822,623
Amendment & Response
Attorney Docket 8195.28US01

Steidinger, the secondary adhesive pattern is taught to be between the release coated backer piece 125, 225, 325, or 425 and the part of the integrated label form 121 that surrounds the label 122 and from which the label 122 is removed. (For embodiments after the first embodiment in Steidinger, only different elements are described (Col. 3, line 36), and where elements are in common with the prior art shown in Figs. 1-2, only the initial numeral of an element is changed by 100 but the remaining two digits are the same when reference is made to such an element (Col. 2, lines 43-47).) The purpose of the secondary adhesive pattern is to hold down the marginal edges of the backer piece 125 to prevent folding over and lifting during feeding and handling. Steidinger, Column 2, line 57 - Column 3, line 18. The secondary adhesive pattern in Steidinger is not within the edge of the label 122, defined by the perforated die-cut 123, labeled only in Figure 3 of Steidinger. The secondary adhesive pattern is located in the margins 126 of the backer piece 125. Steidinger, Column 2, lines 51-54. Therefore, if the teachings of Steidinger are applied to Voy, one of skill in the art would include a secondary adhesive pattern in Voy between the release/carrier sheet 90 of Voy and the edges of the element sheet 81 outside of the boundaries of the labels 117, as shown in Figures 2-4 of Voy. This would help hold the marginal edges of the backer piece in place, as taught in Steidinger.

The combination of Voy and Steidinger therefore does not teach all the elements of claim 1. The combination of Voy and Steidinger does not teach a first adhesive field with discontinuous adhesive covering no more than 80% of its area, including an outer perimeter adhesive field adjacent to and within an outer perimeter edge of the flexible label substrate, where a die-cut in the flexible label substrate defines the outer perimeter edge. Therefore claim 1 is patentable over Voy in view of Steidinger for at least this reason, and dependent claims 3-12, 21 and 36 are also patentable for at least this reason.

Claim 13 relates to a roll of adhesive constructions including a release liner and at least 10 spaced adhesive constructions secured to the extension of release liner.

Steidinger does not teach an extension of release liner with spaced adhesive constructions. Instead, individual portions of release-coated backer pieces 25, 125, 225, 325, or 425 are attached along an integrated label form 21, 121, 221, 321 or 421. In addition, the combination of Voy in view of Steidinger does not teach a first adhesive

S/N 09/822,623
Amendment & Response
Attorney Docket 8195.28US01

field with discontinuous adhesive covering no more than 80% of its area, where the first adhesive field is positioned on a flexible substrate of an adhesive construction adjacent to and within an outer perimeter edge of the flexible label substrate, where a die-cut in the flexible label substrate defines the outer perimeter edge, as discussed above in relation to claim 1. Therefore, claim 13 and dependent claims 15, 22 and 37 are patentable over Voy in view of Steidinger for at least this reason.

Claim 23 relates to an adhesive construction including a first adhesive field and a second adhesive field having different adhesive coverage where the two adhesive fields are applied in a single screen-printing process. Claim 24 further details the screen used in the screen-printing process to achieve the two different adhesive fields. Although Voy mentions the use of a screen-printing technique at Column 7, lines 2-3, Voy does not teach using the same screen-printing process for applying fields of adhesive with two different values of adhesive coverage. Voy only describes one adhesive area and an adhesive-free area. Steidinger does not teach using screen-printing techniques for applying adhesive. Therefore, claim 23 and dependent claims 24-35 are patentable over Voy in view of Steidinger for at least this reason.

Claims 10 and 11 specify that the outer perimeter edge has no segment of extension greater than 8 mm and 5 mm, respectively, at which there is not adhesive on the substrate first side and immediately adjacent the outer perimeter edge. Steidinger's secondary adhesive field is not taught to be configured in this way, and appears to have larger gaps between areas of adhesive in all embodiments. As a result, claims 10 and 11 are further patentable over the cited references. Claims 33 and 34 are further patentable for these reasons also.

Claims 35-36 specify that the adhesive pattern in the outer perimeter adhesive field covers at least about 30% of its area. In contrast, Steidinger does not teach this percentage of coverage for its secondary adhesive fields 128, 228, 328 or 428, and the percentage of coverage appears to be much less. Therefore, claims 35 and 36 are further patentable over the cited references.

S/N 09/822,623
Amendment & Response
Attorney Docket 8195.28US01

No Motivation to Combine

In addition to the claim distinctions from the combination discussed above, there is also no motivation to combine Voy and Steidinger, and Voy teaches away from the combination. In explaining the alleged motivation to combine the references, the Examiner notes that the purpose of having a transverse leading edge of each label that is adhesive-free is to improve releasability of the labels from the carrier sheet during label application. The Examiner also notes that Voy mentions at column 19, lines 5-7 that, if desired, the adhesive can be applied in zones with peripheries precisely corresponding to the peripheries of the labels. The Examiner further argues that Steidinger teaches that loose unglued margins cause folding over or getting caught in the process of feeding forms. However, this teaching in Steidinger relates to the loose unglued margins of the release-coated backer piece 125, 225, 325, and 425 in Steidinger, not to the unglued margin areas of a label area 122. In fact, the label areas shown in Steidinger are completely coated with a uniform adhesive area 124 that extends up to and beyond the periphery of the label area 122. Since Steidinger addresses a different problem than Voy, there is no motivation to combine these two references as argued.

In addition, Applicant respectfully submits that modifying the construction taught in Voy to have a secondary adhesive zone instead of an adhesive free zone at its periphery would not further the goal of releasability of the label. In contrast, it would decrease the releasability of the label compared to the construction that is taught in Voy.

In addition, Voy teaches away from a modification to have a reduced adhesive zone at its periphery. Voy states at column 4, lines 43-49 that an object of the invention is to allow the die cutting of each element without fouling the apparatus with adhesive or jamming the apparatus. By providing an adhesive free zone, the apparatus is not fouled with adhesive. However, the provision of a reduced adhesive zone at the periphery would not achieve this goal. In addition, at column 3, line 63 through column 4, line 10, Voy discusses the advantage of preventing adhesive migration beyond predetermined boundaries prior to curing of the adhesives. This goal would also not be achieved if the adhesive free zone were replaced with a reduced adhesive zone.

S/N 09/822,623
Amendment & Response
Attorney Docket 8195.28US01

Again, Applicant respectfully submits that modifying a characteristic of an invention where the modification would defeat the purpose of the original characteristic is not appropriate in constructing an obviousness rejection. *In re Haruna*, 259 F.3d 1327, 1336 (Fed. Cir. 2001). As discussed in the previous response, in *Haruna*, the claim at issue was to an ornamental design for a prerecorded optical disk. *Id* at 1329. The design differed from conventional prerecorded optical disks in that the metalized region of the disk stopped well short of the outer rim and the disk had a relatively wide transparent region adjacent to the outer rim. *Id* at 1329. The Examiner rejected the claim based on a patent describing a way of manufacturing disks to conceal any cosmetic defects in an outer zone by treating a surface of the outer zone so that the disk reflects light falling in the outer zone at least partially diffusely and/or absorbs at least partially. *Id* at 1331. The cited patent taught that where the outer zone is not metalized, the outer zone might be treated to provide a matte finish or a colored surface or pattern. *Id* at 1336. The Examiner and the Board of Patent Appeals And Interferences determined that the cited patent, combined with the general knowledge that conventional disks have a narrow transparent region at their rims, rendered the claimed design obvious. *Id* at 1336. However, the Federal Circuit found that this determination ignored the teachings of the cited patent. *Id* at 1336. The cited reference taught away from the claimed invention because providing a transparent region would not conceal any defects and would result in a large region where defects would be readily apparent. *Id* at 1336.

Similarly, in the obviousness rejection at issue, changing the adhesive free zone of Voy to make it a secondary adhesive zone would hinder the purpose of having the adhesive free zone in the first place. Therefore, Voy teaches away from combining Voy with Steidinger.

For the reasons discussed above, claims 1, 13 and 23 are patentable over Voy in view of Steidinger. Dependent claims 3-12 and 14-22, 24, and 26-37 are also patentable for at least the same reasons, and the other reasons discussed above. In view of the above, favorable reconsideration of the claims is respectfully requested.


SN 09/822,623
Amendment & Response
Attorney Docket 8195.28US01

Attached hereto is a marked-up version of the changes made to the claims by the current amendment. The attached page is captioned "Version with markings to show changes made."

Respectfully submitted,

MERCHANT & GOULD P.C.
P.O. Box 2903
Minneapolis, Minnesota 55402-0903
(612) 332-5300

Date: 4-29-2003


Mara E. Liepa
Reg. No. 40,066

S/N 09/822,623
Amendment & Response
Attorney Docket 8195.28US01

VERSION WITH MARKINGS TO SHOW CHANGES MADE

In the Claims

Claim 25 has been cancelled.

Claims 1, 10, 13 and 23 have been amended as follows.

1. (Twice Amended) An adhesive construction comprising:
 - (a) a flexible label substrate having a first side and defining an outer perimeter edge, wherein a die-cut in the flexible label substrate defines the outer perimeter edge;
 - (b) a first adhesive field comprising pressure sensitive adhesive and an outer perimeter adhesive field positioned on the first side of the flexible label substrate and adjacent and within the outer perimeter edge;
 - (i) the first adhesive field being a discontinuous pattern of adhesive with adhesive covering no more than 80% of an area of a portion of the first side of the flexible label substrate defined by the first adhesive field; the area of a portion of the first side of the flexible label substrate defined by the first adhesive field being at least 10 sq. mm. and,
 - (c) a second adhesive field comprising pressure sensitive adhesive and an inner adhesive field spaced from the outer perimeter edge and completely surrounded by the first adhesive field;
 - (ii) the second adhesive field covering at least 90% of an area of a portion of the first side of the flexible label substrate defined by the second adhesive field; the area of a portion of the first side of the flexible label substrate defined by the second adhesive field being at least 10 sq. mm.

S/N 09/822,623
Amendment & Response
Attorney Docket 8195.28US01

10. (Once Amended) An adhesive construction according to claim [2] 1 wherein:
- (a) the outer perimeter edge has no segment of extension of greater than 8 mm., at which there is not adhesive on the substrate first side and immediately adjacent the outer perimeter edge.
13. (Twice Amended) A roll of adhesive constructions; the roll comprising:
- (a) an extension of release liner;
 - (b) at least 10 spaced adhesive constructions secured to the extension of release liner; each adhesive construction comprising:
 - (i) a flexible label substrate having a first side and defining an outer perimeter edge, wherein a die-cut in the flexible label substrate defines the outer perimeter edge;
 - (ii) a first adhesive field comprising pressure sensitive adhesive and an outer perimeter adhesive field positioned on the first side of the flexible label substrate and adjacent and within the outer perimeter edge;
 - (A) the first adhesive field being a discontinuous pattern of adhesive with adhesive covering no more than 80% of an area of a portion of the first side of the flexible label substrate defined by the first adhesive field; the area of a portion of the first side of the flexible label substrate defined by the first adhesive field being at least 10 sq. mm.[.]; and,
 - (iii) a second adhesive field comprising pressure sensitive adhesive and an inner adhesive field spaced from the outer perimeter edge and completely surrounded by the first adhesive field;
 - (A) the second adhesive field covering at least 90% of an area of a portion of the first side of the flexible label substrate defined by the second adhesive field; the area of a portion of the first side of the flexible label substrate defined by the second adhesive field being at least 10 sq. mm.

S/N 09/822,623
Amendment & Response
Attorney Docket 8195.28US01

23. (Once Amended) An adhesive construction comprising:
- (a) a flexible label substrate [defining a] having a first side and defining an outer perimeter edge;
 - (b) a first adhesive field comprising pressure sensitive adhesive and an outer perimeter adhesive field positioned on the first side of the flexible label substrate and adjacent the outer perimeter edge;
 - (i) the first adhesive field being a discontinuous pattern of adhesive with adhesive covering no more than 80% of an area of a portion of the first side of the flexible label substrate defined by the first adhesive field; the area of a portion of the first side of the flexible label substrate defined by the first adhesive field being at least 10 sq. mm. and,
 - (c) a second adhesive field comprising pressure sensitive adhesive and an inner adhesive field spaced from the outer perimeter edge and completely surrounded by the first adhesive field;
 - (ii) the second adhesive field covering at least 90% of an area of a portion of the first side of the flexible label substrate defined by the second adhesive field; the area of a portion of the first side of the flexible label substrate defined by the second adhesive field being at least 10 sq. mm.;
 - (d) wherein the first adhesive field and second adhesive field are applied in a single screen-printing process.

New claims 33-37 have been added.